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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,769	01/21/2000	Pierre Sabatier	160383.90121	4877

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EXAMINER

LIN, KENNY S

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 09/12/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/488,769

Applicant(s)

SABATIER ET AL.

Examiner

Kenny Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 6-11 are presented for examination.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The following claim language render the claims indefinite:

- i. As per claim 11, it is not clear what “in which signals are exchanged...” refers to (i.e., where is the “in which” referring to? Or is this an additional step? Who is exchanging the signals?).

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 6-8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonsson, US 6,272,214.

6. As per claim 6, Jonsson taught the invention as claimed including a process for establishing communication between a first device and a second device on a computer network of the Internet type (Internet), wherein the first device and the second device are also operable for communication on a telephone network (PSTN), the process comprising:

- a. the first device calling the second device on the telephone network to invite the second device into communication on the computer network (col.3, lines 17-21), the first device transmitting a message on the telephone network to the second device (col.3, lines 17-21), said message including a computer address having a first part designating a location of a service provider memory for communicating with the first device and the second device on the computer network, and said computer address having a second part corresponding to a location in said memory for accessing a second message from the first device (col.3, lines 8-12,

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URL is inherently known to specify the domain name of the service provider and the folder for the web page. For example, [www.uspto.gov/main/aboutuspto.htm](http://www.uspto.gov/main/aboutuspto.htm) has a domain name of “www.uspto.gov” and a “main” folder that stores “aboutuspto.htm” file),

- b. the first device connecting to the computer network to receive the first part of the computer address and to incorporate the first part of the computer address into said message transmitted on said telephone network to the second device (col.3, lines 12-16, col.4, lines 11-22, col.5, lines 10-124), and
- c. the second device connecting to the computer network, and using the first part of the computer address for establishing communication with said service provider memory (col.3, lines 29-43).

7. As per claim 7, Jonsson further taught that the first device calls the second device on the telephone network prior to connecting to the computer network (col.1, lines 41-44).

8. As per claim 8, Jonsson further taught that in which the first device establishes communication on the computer network to receive the first part of the computer address, and incorporates said first part in said message before calling said second device on said telephone network (col.3, lines 8-21).

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9. As per claim 11, Jonsson further taught that signals are exchanged, including signals containing an identifier of the device calling via the telephone network (col.3, lines 8-12, 17-21, col.6, lines 9-11).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson, US 6,272,214, in view of Vapaakoski et al (Hereinafter Vapaakoski), US 6,164,547.

12. As per claim 9, Jonsson did not specifically teach that the first device communicates with the second device via the telephone network to transmit a code word designating communication compatibility, which the second device subsequently transmits via the computer network to the first device, to establish communication with the first device through the computer network. Vapaakoski taught to transmit code word to designate communication compatibility for the devices to establish communication (abstract, col.1, lines 55-67, col.2, lines 1-3, 7-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jonsson and Vapaakoski because Vapaakoski's teaching of checking the compatibility using codes helps Jonsson's system to verify whether the communication

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established between the devices are efficient or not and to prevent damage in the devices (col.1, lines 22-29).

13. As per claim 10, Jonsson did not specifically teach that during communication between the first device and the second device via the telephone network, signals are exchanged to verify compatibility of the first device and the second device for communication via the computer network. Vapaakoski taught to exchange code word to designate communication compatibility for the devices to establish communication (abstract, col.1, lines 55-67, col.2, lines 1-3, 7-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jonsson and Vapaakoski because Vapaakoski's teaching of checking the compatibility helps Jonsson's system to verify whether the communication established between the devices are efficient or not and to prevent damage in the devices (col.1, lines 22-29).

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Solomon, US 5,974,043.

Gittins et al, US 6,052,372.

Strauss et al, US 5,940,598.

Curry et al, US 6,181,695.

15. Applicant's arguments with respect to claims 6-11, filed on 6/23/2003, have been considered but are moot in view of the new ground(s) of rejection.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (703)305-0438. The examiner can normally be reached on 8 AM to 5 PM Tuesday to Friday and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. Additionally, the fax numbers for Group 2100 are as follows:

Official Responses: (703) 872-9306




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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-6121.

ksl

August 29, 2003

  
ZARNI MAUNG  
PRIMARY EXAMINER